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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,646	08/24/2000	Shinichiro Hayashi	13041.5US01	3347

7590 06/16/2005

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EXAMINER
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VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/645,646		HAYASHI ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Hai Vo		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,6-30, 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) 27-29 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,6-26,30 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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1. The 112 claim rejections have been overcome by the present amendment.
2. The art rejections over Noboru (JP 08-258493) are withdrawn in view of the present amendment. Noboru's skeleton structure is made of a porous inorganic material which is chemically different from a porous organic polymer of the skeleton structure as recited in the claims.
3. The art rejections over Toyosawa et al (US 5,716,997), Shimizu et al (US 4,911,974), Giez et al (US 5,366,999) and Imashiro et al (US 5,413,853) are maintained.

***Election/Restrictions***

4. Newly submitted claim 38 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 3, 6-26, 30, and 37 drawn to an eraser, classified in class 428, subclass 304.4+.
  - II. Claim 38, drawn to a method of erasing written matter, classified in class 345, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product

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as claimed can be used in a materially different process of using that product such as bioconversion processes (see US 5,366,999).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 38 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 6-21, 26, 30 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Toyosawa et al (US 5,716,997) substantially as set forth in the 10/13/2004 Office Action.

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8. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyosawa et al (US 5,716,997) substantially as set forth in the 10/13/2004 Office Action.
9. Claims 7, 12-21, 26, 30 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shimizu et al (US 4,911,974) substantially as set forth in the 10/13/2004 Office Action.
10. Claims 3, 7, 11-21, 23, 26, 30, and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Giez et al (US 5,366,999) substantially as set forth in the 10/13/2004 Office Action.
11. Claims 10, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giez et al (US 5,366,999) substantially as set forth in the 10/13/2004 Office Action.
12. Claims 3, 6, 7, 11-21, 26, 30 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Imashiro et al (US 5,413,853) substantially as set forth in the 10/13/2004 Office Action.
13. Claims 6, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imashiro et al (US 5,413,853) substantially as set forth in the 10/13/2004 Office Action.
14. Claims 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imashiro et al (US 5,413,853) as applied to claim 37 above, further in view of

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Toyosawa et al (US 5,716,997) substantially as set forth in the 10/13/2004 Office Action.

### ***Response to Arguments***

15. The art rejections over Toyosawa et al (US 5,716,997), Shimizu et al (US 4,911,974), Giez et al (US 5,366,999) and Imashiro et al (US 5,413,853) have been maintained for the following reasons. Applicants argue that none of the cited references discloses or suggests the eraser used for removing information such as written, printed or drawn material from a paper page or drawing sheet. Applicants further assert that the term "eraser" in the preamble breathes life in the claim, defines the nature of the article being claimed and has clear implications in terms of suitable shapes and relative dimensions. Applicants' attention is directed to example 1 of Giez et al (US 5,366,999). The impregnated web has a dimension of 15x15x7mm, which is about the dimension of the eraser. Similarly, the product of Morimoto is the form of a spherical shape with a diameter of 1.5 mm, which is about the size of the eraser. Further, the eraser could have different sizes as dependent upon its intended use. The pencil shape eraser has a size different from the size of the chalkboard eraser. The eraser can be any shape: round, oblong, rectangular, square and etc.. The eraser itself does not necessary imply the suitable shapes and relative dimensions as argued by Applicants. It appears that all the cited references meet all the structural limitations as required by the claims. The prior art composite material comprises a skeleton structure which includes a skeleton portion and a void portion wherein the void portion is filled with an elastic material and the skeleton

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portion is made from an organic polymer. The elastic material is a rubber material or a resin material. Therefore, it is not seen that the composite material could have not been performed differently than the composite material of the present invention in terms of erasing capability. Like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Finally, the preamble "eraser" has not given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Accordingly, the art rejections are thus sustained.

### ***Conclusion***

**16. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

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period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

*Hai Vo*

**HAI VO  
PRIMARY EXAMINER**